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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/530,920	04/08/2005	Jordi Reguant Miranda	HERR5.001APC	2510

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KNOBBE MARTENS OLSON & BEAR LLP  
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EXAMINER
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GWARTNEY, ELIZABETH A

ART UNIT	PAPER NUMBER
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1781

NOTIFICATION DATE	DELIVERY MODE
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04/28/2011

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/530,920	<b>Applicant(s)</b> MIRANDA ET AL.	
	<b>Examiner</b> ELIZABETH GWARTNEY	<b>Art Unit</b> 1781	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 February 2011.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3,7,9-13,18-28 and 30-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,7,9-13,18-28 and 30-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20110218</u>  | 6) <input type="checkbox"/> Other: _____                          |

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### **DETAILED ACTION**

1. The Amendment filed February 18, 2011 has been entered. Claims 4-6, 8, 14-17, 29 and 33-37 are cancelled. Claims 1-3, 7, 9-13, 18-28 and 30-32 are pending.

### **Claim Rejections - 35 USC § 103**

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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**5. Claims 1-3, 7, 9-13, 18-23, 27-28 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mate et al. (“Whey Protein and Acetylated Monoglyceride Edible Coatings: Effect on the Rancidity Process of Walnuts”) in view of Stanley (“Storing Pecans Longer, Better”).**

Regarding **claims 1-3 and 7**, Mate et al. a nut composition comprising shelled walnut pieces coated with a composition comprising acetylated monoglycerides and tocopherols (Abstract, p. 2510/Materials and Methods/Materials, AMG Formulations and Coating Procedure). Mate et al. disclose that acetylated monoglyceride-based coatings or films have a positive effect in delaying the rancidity of walnuts (p.2511/Evaluation of the Effect of AMG-Based Coating). Further, Mate et al. disclose that there is a significant positive effect of the addition of tocopherols into the acetylated monoglyceride-based coating (p. 2512/Evaluation of the Effect of AMG-Based Coating).

While Mate et al. disclose a coating consisting of tocopherol and a coating material, acetylated monoglycerides, the reference does not disclose that the coating material is an edible compound selected from the group consisting of HPMC, HPC, MC, CMC, EMC, maltodextrin and their mixtures.

Stanley teaches pecans coated with a coating material consisting of either methyl cellulose, hydroxypropyl cellulose or carboxymethyl cellulose (paragraph 5). Stanley teaches that the edible coating keeps pecans stored for 10 months at room temperature from becoming rancid (paragraph 2). Stanley teaches that the edible coating gives the pecans a high gloss that improves their appearance (paragraph 5).

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Mate et al. and Stanley are combinable because they are concerned with the same field of endeavor, edible coatings used to extend shelf life of nuts. Given Mate et al. teach that acetylated monoglyceride coatings are used to delay the rancidity of nuts and that tocopherol, i.e. an antioxidant, acts synergistically with the coating material, since Stanley teaches that it was known to coat nuts with cellulose ethers to extend shelf life and also given the nuts a desirable high gloss appearance, it would have been obvious to one of ordinary skill in the art at the time of the invention to have used a cellulose ether, as taught by Stanley, interchangeably with acetylated monoglyceride in the coated nut of Mate et al. because doing so would amount to nothing more than the use of a known oxygen barrier coating or film material for its intended use in a known environment to accomplish entirely expected results. Further, by doing so the nuts would have a high gloss that improves their appearance.

Given Mate et al. teach a coating comprising a mixture of acetylated monoglyceride and tocopherol, i.e. an antioxidant, it necessarily follows that the acetylated monoglyceride is applied (i.e. mixed) to the antioxidant and that that mixture is applied to the surface of the nut.

Regarding **claim 9**, modified Mate et al. disclose all of the claim limitations as set forth above. Mate et al. also disclose that the amount of coating added to the nut varied from 2.8 to 5 wt% (p.2511/Evaluation of the Effect of AMG-Based Coatings).

Regarding **claim 10**, modified Mate et al. disclose all of the claim limitations as set forth above. While Mate et al. disclose nut pieces coated with just one layer of a coating solution, the reference does not disclose the precise coating thickness. As hardness and continuity of the coating are variables that can be modified, among others by adjusting said thickness of coating, with said hardness and continuity of the coating both increasing as the coating thickness is

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increased, the precise coating thickness would have been considered a result effective variable by one having ordinary skill in the art at the time the invention was made. Accordingly, one of ordinary skill in the art at the time the invention was made would have adjusted, by routine processing, the thickness or amount of the coating material in Mate et al. to obtain the desired balance between the continuity of the coating and the hardness of the final nut product.

Regarding **claim 11**, modified Mate et al. disclose all of the claim limitations as set forth above. Mate et al. disclose that the composition further comprises ascorbyl palmitate, i.e. nutraceutical (p.2509/Introduction, p.2510/AMG Formulations and Coating Procedure).

Regarding **claims 12, 13 and 23**, modified Mate et al. disclose a method for making coated nuts according to **claim 1**, comprising the steps of: (a) applying a coating mixture of antioxidant, i.e. tocopherol, acetylated monoglyceride and ascorbyl palmitate; and (b) cooling said coated walnuts to create a solid acetylated monoglyceride coating.

Given Mate et al. disclose that a solid acetylated monoglyceride coating is created, it necessarily follows that the coating was dried and any solvent removed.

While Mate et al. disclose applying a coating comprising both antioxidant and a barrier coating of acetylated monoglyceride at the same time, the reference does not disclose that the antioxidant is applied in a separate step. Here, Mate et al. disclose substantially the same product produced by substantially the same method as instantly claimed by applicant; where the claimed and prior art products are produced by substantially identical processes, a prima facie case of obviousness has been established. To switch the order of performing process steps, i.e. the order of the applying the ingredients onto the nut, would be obvious absent any clear and convincing evidence and/or arguments to the contrary (MPEP 2144.04 [R-1]). "Selection of any

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order of performing process steps is prima facie obvious in the absence of new or unexpected results.”

Regarding **claims 18-19**, modified Mate et al. disclose all of the claim limitations as set forth above. While Mate et al. disclose a coating comprising 14% tocopherol, 14% ascorbyl palmitate, and coating material, the reference does not explicitly disclose wherein the coating material is in a concentration between 1% -50% by weight. Mate et al. disclose that the amount of coating applied is dependent on the viscosity of the coating material. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to have adjusted the concentration of the coating material of modified Mate et al., by routine processing, to achieve a desired coating viscosity.

Regarding **claim 20**, Mate et al. disclose all of the claim limitations as set forth above. Mate et al. also disclose that the walnuts were placed on pins and dipped in the coating mixture (p.1520/AMG Formulations and Coating Procedure).

Regarding **claim 21**, Mate et al. disclose all of the claim limitations as set forth above. Mate et al. also disclose that 2.8% to 5% acetylated monoglyceride coating was added to the walnuts (p.2511/Evaluation of the Effect of AMG-Based Coatings).

Regarding **claim 22**, Mate et al. disclose all of the claim limitations as set forth above. Mate et al. disclose dipping the nuts in a mixture of the coating material and thereafter, cooling to produce nut pieces with a solid coating layer (p. 2510/AMG Formulations and Coating Procedure). Given Mate et al. disclose cooling the coated nuts to produce a hard coating, it necessarily follows that the coating is dried in the cooling process. Further, given Mate et al.

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disclose cooling with no specific mention of a cooling apparatus, it necessarily follows that the coated nuts are cooled at ambient temperature, i.e. a temperature well below 200°C.

Regarding **claims 27 and 28**, modified Mate et al. disclose all of the claim limitations as set forth above. While Mate et al. discloses a method for producing a nut coated with an edible coating including application and cooling/drying stages, the reference does not explicitly disclose repeating the stages a variable number of times. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have repeated the application and drying stages. Mere duplication of the application and drying steps has not patentable significance unless a new and unexpected result is produced. For each application and cooling/drying stage, Mate et al. disclose that a thin layer of solid coating material is formed on the nuts (p.2510/AMG Formulations and Coating Procedure).

Regarding **claim 30**, modified Mate et al. disclose all of the claim limitations as set forth above. Mate et al. disclose that the composition further comprises ascorbyl palmitate, i.e. nutraceutical (p.2509/Introduction, p.2510/AMG Formulations and Coating Procedure).

**6. Claims 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mate et al. (“Whey Protein and Acetylated Monoglyceride Edible Coatings: Effect on the Rancidity Process of Walnuts”) in view of Stanley (“Storing Pecans Longer, Better”) as applied to claim 12, and further in view of Fellows (“Food Processing Technology-Principles and Practice”).**



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Regarding **claims 24-26**, modified Mate et al. disclose all of the claim limitations as set forth above. While Mate et al. disclose drying the coated nuts at ambient temperature, the reference does not explicitly disclose drying as recited in claims 24-26.

Fellows teaches that rotary drum and tunnel driers were well known in the art at the time the invention was made (p. 324). Further, it was well known that tunnel drying includes multiple stages with the first stage being the hottest, the exit stage the coldest, and the intermediate stage can include infra-red radiation. Fellows also teaches that the type of dryer chosen will depend on cost, capacity, fuel efficiency, and labor requirement (p.325). As the instant specification is silent to unexpected results, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use any drier type, including a rotary drum drier and a drying tunnel with three stages to dry the coating material of modified Mate et al. because it would amount to nothing more than the use of a known drying process for its intended use in a known environment to accomplish entirely expected results.

**7. Claims 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mate et al. (“Whey Protein and Acetylated Monoglyceride Edible Coatings: Effect on the Rancidity Process of Walnuts”) in view of Stanley (“Storing Pecans Longer, Better”) as applied to claims 1 and 12, and further in view of Kelly (US 2,468,078).**

Regarding **claims 31 and 32**, modified Mate et al. disclose all of the claim limitations as set forth above. Mate et al. does not disclose a coated nut further comprising an additional coating selected from the group consisting of sugar, honey, salt and chocolate.

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Kelly teaches that it was known to salt nuts comprising a protective edible coating material (C1/1-5, Claim 1). Kelly teaches applying salt to the outer surface of a nut comprising an edible coating (Claim 1).

Mate et al. and Kelly are combinable because they are concerned with the same field of endeavor, namely, coated nut compositions and processes to coat nuts. Given modified Mate et al. teach nuts comprising a protective coating, since Kelly et al. teach that it was known to salt coated nuts, it would have been obvious to one of ordinary skill in the art at the time of the invention to have coated the nuts of modified Mate et al. with salt for the purpose of making a salted nut product.

### **Response to Arguments**

**8. Applicants' arguments have been considered but are moot in view of the new ground(s) of rejection.**

However, applicants' arguments with respect to Mate et al. are noted. Applicants submit that Mate et al. disclose a coated nut comprising a single homogenous layer comprising an antioxidant and acetylated monoglyceride or corn oil. Applicants argue that in contrast, Claims 1 and 12 relate to a nut and a process of making a coated nut where an antioxidant is applied to the surface of the nut and an edible film is applied to the antioxidant. Applicants note that Mate et al. does not disclose applying an antioxidant in a separate step. Applicants find that "the configuration of the claimed nuts is therefore distinct from the nut of Mate."

It is the Examiner's position that Mate et al. disclose substantially the same product produced by substantially the same method as instantly claimed by applicant; where the claimed

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and prior art products are produced by substantially identical processes, a prima facie case of obviousness has been established. To switch the order of performing process steps, i.e. the order of the applying the ingredients onto the nut, would be obvious absent any clear and convincing evidence and/or arguments to the contrary (MPEP 2144.04 [R-1]). "Selection of any order of performing process steps is prima facie obvious in the absence of new or unexpected results."

Applicants argue that a "prima facie case of obviousness may not be established by merely selecting the order of performing the process steps of Mate because Mate teaches a single application step only."

It is the Examiner's position that by performing the steps simultaneously rather than distinct steps where an antioxidant is applied in a separate step from the coating material, is no different. In this case, the order of performing the steps includes performing the steps together or simultaneously. There is not evidence on the record that a nut product wherein an antioxidant is applied simultaneous to a coating material performs differently or exhibits different properties than a nut product with two distinct layers of antioxidant and coating material.

### Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ELIZABETH GWARTNEY whose telephone number is (571)270-3874. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, D. Lawrence Tarazano can be reached on (571) 272-1515. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. Lawrence Tarazano/  
Supervisory Patent Examiner, Art Unit 1781

/E. G./  
Examiner, Art Unit 1781